UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,519	02/23/2006	Roman Stauch	06-122	8617

34704 7590 07/31/2007

BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN, CT 06510

EXAMINER	
WISTERMAYER, ALEXIS M	

ART UNIT	PAPER NUMBER
3709	

MAIL DATE	DELIVERY MODE
07/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/569,519	STAUCH, ROMAN	
	Examiner	Art Unit	
	Alexis M. Wistermayer	3709	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 8, and 11* is/are rejected.

7)☒ Claim(s) *5-7,9 and 10* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/08/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 5, 6, 7, 9 and 10 have not been further treated on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 8, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Li (PG Pub 2003/0204190).

Regarding Claims 1, 2, and 8: Li teaches a device for extending bones, comprising two elements/bone distractor bodies (Figure 1 Elements 14 and 16) that move axially/longitudinally in relation to one another (Page 2 Paragraph 29), in which the first element/bone distractor body (Figure 1 Element 14) is configured as a receiving

sleeve in which at least one radial locking bore/screw hole (Figure 1 Element 48) is provided at one end.

Regarding Claim 11: Li teaches a similar device in that Figure 2, Element 14 engages as an outer sleeve/chamber over Element 16 and receives it.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li (PG Pub 2003/0204190) as applied to claims 1 and 2 above, and further in view of Baumgart et al (US Pat 5623955).

Li teaches the basic claimed device as stated above in Claims 1 and 2.

Li does not teach a device for extending/expanding bones that includes an electric motor and a thread or spindle system. However, Baumgart et al. teaches a medullary nail that includes an electric motor that is able to drive a spindle/rod through a thread system/screwheaded bore (Column 2 Lines 10 through 35). Li and Baumgart et al. are analogous art because they are in the same field of endeavor, namely bone lengthening devices. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Baumgart et al. electric motor and thread

system with Li's bone lengthening device. The motivation would have been to offer an alternate means of making the device expandable.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li (PG Pub 2003/0204190) and Baumgart et al. (US Pat 5623955), as applied to claims 1 through 3 above, and further in view of Shouts (US Pat 5,919,192).

Li teaches the basic claimed device as stated above in Claims 1 through 3.

Li does not teach a device with at least one displacement sensor assigned to the drive shaft. However, Shouts teaches a bone device with a sensor that senses the displacement of a spring when forces are applied to it (Column 3 Lines 40 through 60). Li and Shouts are analogous art because they are from the same field of endeavor, namely bone fracture devices. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Shouts' sensor in Li's bone extending device. The motivation would have been to offer an alternative means for extending the bone device to an optimal length to promote bone re-growth.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 through 3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/569,665 in view of Li (PGPub 0204190).

Regarding Claims 1 through 3: Claim 1 of Application No. 10/569,665 teaches a device for extending bones with two elements that move in relation to one another, said two elements being connected by at least one drive element, and the basic claimed planetary roller system.

Application No. 10/569,665 does not teach a receiving sleeve with at least one radial locking bore. However, Li teaches a bone lengthening/expanding device that has a first element configured as a receiving sleeve and one radial locking bore/screw hole (Figure 2 Elements 14 and 48, respectively). Application No. 10/569,665 and Li are analogous because they are both concerned with bone-extending devices. It would have been obvious to a person of ordinary skill in the art to use the two elements moving in relation to each other and the planetary roller system taught by Application No. 10/569,665 with Li's receiving sleeve and radial locking bore to offer an alternative means of extending the bone device.

This is a provisional obviousness-type double patenting rejection.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexis M. Wistermayer whose telephone number is 571-272-1197. The examiner can normally be reached on Monday - Friday 8 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMW 07/16/2007

MARK EASHOO, PH.D.
SUPERVISORY PATENT EXAMINER
16/Jul/07